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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/993,699 12/18/97 HANEY

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EXAMINER

QM11/0204

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ART UNIT

PAPER NUMBER

3723

**DATE MAILED:**

02/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/993,699</b>	Applicant(s) <b>Haney</b>
	Examiner <b>Robert Rose</b>	Group Art Unit <b>3723</b>

Responsive to communication(s) filed on Nov 10, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-15 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## DETAILED ACTION

1. Claim 16 has been canceled.
2. Claims 14-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 14, lines 10-11 the recitation of the platen moving in a translational orbit when the two shafts are rotated is without supporting structure, in that no means to transmit the rotational motion of the shafts to a translational orbital motion of the platen is recited, and therefore is deemed incomplete. What structure accomplishes the recited change of motion? How is the translational orbit derived from rotation of the second and third shafts? In claim 15, line 4 the phrase "the second and third shafts" is without proper antecedent support.
3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).  
  
A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
4. Claims 1-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 5702287. This is a double patenting rejection.

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The claims are identical except for the omission of the words “sheet of” before the term “sandpaper”. However, the term “sandpaper” is deemed to encompass the limitation of a “sheet”.

5. Claims 14-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2, 4-5, and 10-11 of prior U.S. Patent No. 5443414. This is a double patenting rejection. The recitation of the movable brace supported by the frame being “operatively connected” is deemed to constitute the same scope as the term “linked”.

6. Applicant's arguments filed November 10, 1998 have been fully considered but they are not persuasive. With regard to claims 1 and 3, Applicant has argued against the applicability of the double patenting rejection, relying upon a broader interpretation of the term “sandpaper” than the recitation “sheet of sandpaper”. However, in the examiner's view the term “sandpaper” inherently encompasses all variants of abrasive sheet material beyond a flat four cornered member. Thus, there is no substantive change in scope of the claims by deleting the term “sheet of”. Further, with regard to claim 14, the term “operatively connected” is deemed to be of the same scope as the term “linked”. Applicant's argument that the term “linked” can be more narrowly interpreted by some is not well taken, since all terms in a claim must be given their broadest reasonable interpretation. In this instance, the term “linked” is regarded as synonomous with “operatively connected”.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

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January 27, 1999.

ROBERT M. ROSE  
PRES. & MGR

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 Robert M. Rose